

REMARKS

Status of the Claims

Claims 1-16 are currently pending in the present application. The Office Action is non-final. Claims 1, 4, 5, 8, 10-12, 14, 15 and 16 have been amended without prejudice to or disclaimer of the subject matter contained therein. Support for the amendments can be found at least at page 5, paragraph 14; page 16, paragraph 35; and page 17, paragraph 38 to page 19, paragraph 43. No new matter has been added by way of the amendments.

Based upon the above considerations, entry of the present Amendment is respectfully requested.

Issue under 35 U.S.C. § 101

Claims 15 and 16 are rejected as improper under 35 U.S.C. § 101, because method claims are required to recite process steps. Claims 15 and 16 have been amended to recite process steps. Accordingly, Applicants respectfully request that the rejection of claims 15 and 16 under 35 U.S.C. § 101 be withdrawn.

Issue under 35 U.S.C. § 112, first paragraph, enablement

Claims 1-16 are rejected under 35 U.S.C. § 112, first paragraph. It is alleged in the Office Action that the Specification does not reasonably provide enablement for any process other than the derivatization of a highly cross-linked polystyrene (HCP) solid support by reaction of a functional group attached to said HCP, possibly with a compound of claim 1 to create a solid support derivatized to serve as a starting point for nucleic acid synthesis. Applicants respectfully traverse.

Claims 1-11 are directed to a 3'-end nucleoside unit. While the enablement standard requires that one of skill be able to make and use the claimed invention, there is no reason that one of skill would not be able to use the 3'-end nucleoside unit in the absence of a specific solid support. One of skill in the art would understand that the 3' terminal nucleoside is generally not attached to the solid support until the first cycle of oligonucleotide chain assembly. Claims 12-16 have been amended so that they no longer depend from claim 1, and thus their rejection under

35 U.S.C. § 112, first paragraph, is now moot. Thus, Applicants respectfully request that the rejection of claims 1-16 under 35 U.S.C. § 112, first paragraph, be withdrawn.

Issue under 35 U.S.C. § 112, second paragraph, indefiniteness

Claims 1-16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse.

With regard to claims 1, 10 and 11, in the Office Action, it is asserted that formula I (of claim 1) fails to completely describe the genus of chemical compounds being claimed. Applicants respectfully disagree with the Examiner's assertion, but have amended formula I to further specify the claimed 3'-end nucleoside unit comprising phosphoramidite, in order to expedite prosecution of the present application. After amendment of formula I, the structures of the compounds recited in claims 10 and 11, should be clear.

It is stated in the Office Action that the recitation of a phosphate protecting group in claims 4 and 5 is incorrect, because the claims are directed to phosphoramidites rather than phosphate esters. Applicants have amended claims 1, 4, and 5 to recite a "protecting group" rather than a "phosphate protecting group."

In the Office Action, the language of claim 8 was found to be unclear. Applicants have amended claim 8 to clarify that the benzene ring structure ($-(C_6H_4)-$) of formula I has a substituent.

It is stated in the Office Action that claim 12 does not completely identify the structure Applicants intend to claim. Applicants respectfully disagree, but Applicants have amended claim 12 to recite formula II to further clarify how a 3'-end nucleoside unit is bound to a solid support in order to expedite prosecution of the instant application. Claims 13-16 depend from claim 12.

In the Office Action, it is stated that method claims 15 and 16 are incomplete, because no process steps are recited. Applicants have amended claims 15 and 16 to recite process steps.

In view of the discussion above, and amendments made to the claims, Applicants respectfully request withdrawal of the rejection of claims 1-16 under 35 U.S.C. § 112, second paragraph.

CONCLUSION

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Stephanie A. Wardwell, Reg. No. 48,025, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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Attachment: Replacement Sheet for Figure 1 (1 page)